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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,745	11/20/2001	Mark S. Garrison	680.0039USU	9671

7590 06/17/2005

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/989,745

Applicant(s)

GARRISON ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4-7, 10, 12, 13, 15, 16, 20 and 22-35 is/are pending in the application.
- 4a) Of the above claim(s) 31-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 10, 12, 13, 15, 16, 20, 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/14/2005</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on March 21, 2005. Claims 1, 4-7, 10, 11, 12, 13, 15, 16, 20, 22-35 are pending, and claims 31-35 have been withdrawn from consideration. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action dated November 17, 2004, are withdrawn in view of claim amendment. Claim rejection made under 35 U.S.C. §103 (a) as indicated in the same Office action is withdrawn and modified to address the claim amendment.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 4-7, 10, 12, 13, 15, 16, 20, 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bara et al. (US 6224851 B1) in view of Occupational Safety & Health Administration data (Chemical Sampling Information: Ethyl Perfluorobutyl Ether), Tsutsumi et al. (English translation, JP 356079613A), and Bretescu (US.6528070 B1).**

Bara teaches cosmetic composition water-in-oil emulsion foundation comprising 20 % by weight of perfluoromethylcyclopentane. See col. 8, Example 2; instant claims 10 and 16. The reference teaches, "the perfluoromethylcyclopentane can advantageously be replaced with an equivalent amount of ethoxynonafluorobutane". See col.8, lines 21-23. The reference teaches that ethoxynonafluorobutane is commercially available as HFE 7200 by 3M (Novec), which is ethoxy perfluorobutane, another name for perfluorobutyl ether. See col. 3, lines 21 – 26. For claims 14 and 15,

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the idea for combining compounds each of which is known to be useful for the same purpose, in order to form a composition which is to be used for the same purpose, flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings the instant claims define nothing more than the concomitant use of conventional perfluoro oil compounds that are interchangeably used in the same cosmetic composition. It would follow that combining perfluorobutyl ether and perfluoromethylcyclohexane is a prima facie obvious subject matter.

The reference teaches using methoxynonafluorobutane and ethoxynonafluorobutane in col. 2, lines 15 – 44, particularly in col. 3, lines 4-7. See instant claims 13. Oil-in-water emulsion is also taught in col. 6, lines 11 – 25. See instant claim 3.

The reference teaches that the fluorinated solvents disclosed therein have vapor pressure that is greater than 20 mbar at 25 °C and boiling points between 20-75 °C, thus the reference suggests that perfluoromethylcyclopentane and ethoxy- and methoxynonafluorobutane are within this limitation. See col. 2, lines 8 – 14; col. 3, lines 14 – 18. The reference is silent as to the specific vapor pressure of the volatile perfluoro solvents.

Bara fails to indicate the “texture” of the composition. Also, while Bara does not indicate the specific viscosity of the composition, the reference teaches that the emulsions are “preferably in the form of creams”. See col. 7, line 8.

OSHA data teaches that ethyl perfluorobutyl ether has vapor pressure of 109 mmHg (145.32 mbar) at 25 °C.

Tsutsumi teach that whipped stable cosmetic that is "without oil off and shape collapse" is well known in the art. See p. 3, bridging par. While the reference teaches that the whipped cosmetic may be used in a lipstick, foundation, emulsion or cream without emulsifier, there is no teaching of using an aerosol container. See Constitution. See instant claim 29. The whipped stable composition is said to be without "shape collapse", which is viewed to be equivalent property to the claimed textured surface-renewing property. The reference teaches in p. 11 that the invention is also applicable to other cosmetics such as cream and emulsion cosmetics containing surfactants.

Bratescu teaches cosmetic emulsions. The reference teaches that the viscosity of the composition can vary from thin as 100 cps, to cream like consistency of 80,000 cps. See col. 13, lines 33-35. See instant claims 1, 4-6, 26,

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Bara by producing a whipped composition as motivated by Tsutsumi because 1) both references teach cosmetic emulsion and cream form of foundation; 2) Tsutsumi teaches the benefit of stability of the composition in terms of phase separation and shape; 3) and the skilled artisan would have had a reasonable expectation of successfully producing a stable whipped cosmetic composition. It would have been also obvious to the skilled artisan to have adjusted the viscosity of the composition of the combined references to the viscosities

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of cosmetic compositions as motivated by Bratescu, because of an expectation of successfully producing the cosmetic compositions with desired viscosities.

### ***Response to Arguments***

Applicant's arguments filed March 21, 2005 have been fully considered but they are moot in view of new grounds of rejection in part and not persuasive in part.

Applicants assert that Bara does not specifically disclose a composition that is both an oil-in-water emulsion and a cream. The argument is not persuasive because the present rejection is made under obviousness and not anticipatory standard. In fact, the reference clearly teaches in col. 6, lines 11 – 30 that the invention can be either W/O or O/W emulsion, and goes on to teach in col. 7, lines 8-10, that “these emulsions” are preferably in the form of creams. Examiner views that “these emulsions” here refer to both W/O and O/W emulsion types.

Applicants' argument that the Tsutsumi teaching is limited to making emulsifier-free compositions is not persuasive because, as indicated above in the rejection, the reference also teaches that the invention is applicable to composition comprising emulsifiers as well.

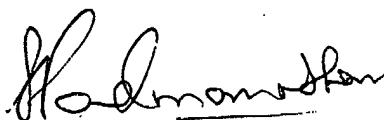
### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

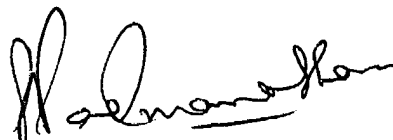


**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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